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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,101	07/14/2003	John Irving	28849/09175	5798
27530 7590 04/22/2009 NELSON MULLINS RILEY & SCARBOROUGH, LLP 1320 MAIN STREET, 17TH FLOOR COLUMBIA, SC 29201				
EXAMINER				
KIM, PAUL				
ART UNIT		PAPER NUMBER		
2169				
MAIL DATE		DELIVERY MODE		
04/22/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/619,101

Applicant(s)

IRVING ET AL.

Examiner

PAUL KIM

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office action is responsive to the following communication: Amendment filed on 3 March 2009.
2. Claims 2-21 are pending and present for examination.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3 March 2009 has been entered.

Response to Amendment

4. Claims 2 and 12 have been amended.
5. No claims have been further cancelled.
6. No claims have been newly added.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. **Claims 12-21** are rejection under 35 U.S.C. 101 because the claims fail to fall within the statutory categories of 35 U.S.C. 101 because the method claim is neither (1) tied to another statutory class (i.e. particular machine or apparatus) nor does it (2) transform underlying subject matter (such as an article or material) to a different state or thing. Accordingly, the method claim (i.e. a process) may be

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performed mentally or manually in a manner that reasonably accomplishes the intended purpose of the recited invention, as claimed, without the use of a structure. That is, the method claims fail to positively recite the particular machine or apparatus to which it is tied. While the claims recite that a "a method for facilitating electronic collaboration in an environment," the claim does not recite an apparatus or machine which executes the method and therefore fails to explicitly recite structural tie to another statutory category nor is statutory subject matter inherently involved in the step.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 2-9 and 12-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Matthews et al (USPGPUB No. 2003/0050986, hereinafter referred to as MATTHEWS), filed on 13 September 2002, and published on 13 March 2003, in view of Sutcliffe et al (US Patent No. 6,249,282, hereinafter referred to as SUTCLIFFE), filed on 10 January 2000, and issued on 19 June 2001, and in further view of Hockey (USPGPUB No. 2004/0064515, hereinafter referred to as HOCKEY), filed on 29 August 2001, and published on 1 April 2004.

11. **As per independent claims 2 and 12**, MATTHEWS, in combination with SUTCLIFFE and HOCKEY, discloses:

An apparatus for electronic collaboration in an environment including a plurality of communities, each of the plurality of communities having a plurality of live users and at least one community administrator, the apparatus comprising:

a community creation database that receives and stores preliminary profile data associated with a candidate user, a submission of the preliminary profile data indicating an interest of the candidate user in joining one of the plurality of communities {See MATTHEWS, Para. 0026, lines 6-8, wherein this reads over "SMC module is configured, for example, To create a user and user profile in database"; and Para. 0028, lines 1-2,

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wherein this reads over "[d]atabase 130 is configured to store member attributes and group attributes";

a first filter that ascertains and controls the preliminary profile data, whereupon the candidate user associated with the preliminary profile data is deemed acceptable for participation in said one of the plurality of communities, wherein the candidate user associated with the validated preliminary profile data thereby becomes a live user of the plurality of live users in said one of the plurality of communities {See MATTHEWS, Para. 0046, wherein this reads over "a private group can be joined by members of the community as approved The GA may, for example, restrict access to the group to a predefined list of users"; and Para. 0049, wherein this reads over "the SPC module, which compares the user's membership attributes to the group's permission criteria to verify whether or not the user has permission to join this group";}

wherein at least one profile is created for the live user, wherein the profile includes descriptive information relating to the live user {See MATTHEW, Para. 0039, wherein this reads over "[t]he member's name or code may be associated in database 130 with additional member attributes"}, said descriptive information includes a first data corresponding to a set of attributes predefined by at least one of the plurality of communities and a second data corresponding to a second set of attributes entered by said candidate user {See MATTHEW, Paras. 0037-0041};

a search engine that searches for data related to another of the plurality of live users in said one of the plurality of communities {See SUTCLIFFE, C7:L58-C8:L12, wherein this reads over "[a] first user can request a search of the database for other users based on characteristic and criteria data"} with which to communicate {See SUTCLIFFE, C4:L7-10, wherein this reads over "a user may choose a particular means to contact another user, such as by e-mail"}, based on at least a portion of said second data; and

a second filter that monitors communications between the plurality of live users within said one of the plurality of communities, the second filter including at least a flagging filter that flags communications between the plurality of live users based on an analysis of at least a textual portion of said communications according to predetermined criteria established by a monitor {See HOCKEY, Para. 0109, wherein this reads over "the thresholds and attributes used for distinguishing a flagged message may be user-configurable"}, wherein the flagging filter is configured to flag communications for review prior to release to their intended recipient {See HOCKEY, Para. 0115, wherein this reads over "other options include changing the message attributes so that it may not be delivered or opened other than by a system administrator, and/or may place the file in a 'quarantine zone'"}.

While MATTHEWS fails to expressly disclose a search engine, SUTCLIFFE provides a method for searching the database for other users based on characteristic and criteria data. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above invention suggested by MATTHEWS by combining it with the invention disclosed by SUTCLIFFE. That is, the inclusion of the disclosed invention in SUTCLIFFE would provide for the searching of members of community according to the descriptive information related to each of the live users.

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One of ordinary skill in the art would have been motivated to do this modification so that a live user may search for and find other live users according to the descriptive information.

Secondly, while MATTHEWS fails to expressly disclose a second filter that monitors communications between a plurality of live users, HOCKEY discloses a system wherein messages may be flagged according to certain thresholds and attributes. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above invention suggested by MATTHEWS by combining it with the invention disclosed by HOCKEY. That is, the modification of the invention disclosed in MATTHEWS by the invention disclosed by HOCKEY would allow for email message or other types of communications to be monitored for Spam and other inappropriateness.

One of ordinary skill in the art would have been motivated to do this modification so that message containing Spam and other inappropriateness may be filtered and intercepted such that said message are not delivered to their intended recipients.

12. **As per dependent claims 3 and 13**, MATTHEWS, in combination with SUTCLIFFE and HOCKEY, discloses:

The apparatus of claim 1, wherein validation of the preliminary profile data includes an administrator of said one of the plurality of communities approving the candidate user {See MATTHEWS, Para. 0045, hereinafter referred to as "[t]he GA may also have authority to manage group membership, wherein members may be added to or deleted from a group membership list by the GA"}.

13. **As per dependent claims 4 and 14**, MATTHEWS, in combination with SUTCLIFFE and HOCKEY, discloses:

The apparatus of claim 1, wherein validation of the preliminary profile data includes automatic validation based on one or more attributes of the preliminary profile data {See MATTHEWS, Para. 0044, wherein this reads over "such requests may be processed by an automated approval process"}.

14. **As per dependent claims 5 and 15**, MATTHEWS, in combination with SUTCLIFFE and HOCKEY, discloses:

The apparatus of claim 4, wherein the one or more attributes include one or more of previous approval by an administrator of a specific other one of the plurality of communities and previous validation as a live user in said one of the plurality of

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communities {See MATTHEWS, Para. 0043, wherein this reads over "[r]equests may also be denied for persons who have in the past violated community rules"}.

15. **As per dependent claims 6 and 16, MATTHEWS, in combination with SUTCLIFFE and HOCKEY, discloses:**

The apparatus of claim 1, wherein the preliminary profile data indicates an interest of the candidate user in joining at least one other of the plurality of communities {See MATTHEWS, Para. 0047, wherein this reads over "searches and/or filters may assist members in finding a group to join"}.

16. **As per dependent claims 7 and 17, MATTHEWS, in combination with SUTCLIFFE and HOCKEY, discloses:**

The apparatus of claim 1, wherein the at least one profile includes one or more of:

a group profile that is accessible to the plurality of live users in said one of the plurality of communities {See MATTHEWS, Figure 4},

an individual profile that is not accessible to the plurality of live users in said one of the plurality of communities, and

a project profile that includes blind contact information regarding the live user.

It is noted that because the "an individual profile" and "a project profile" were optionally recited within the claim, they will not be give consideration for the remainder of this Office action nor will prior art be applied to said optionally recited elements..

17. **As per dependent claims 8 and 18, MATTHEWS, in combination with SUTCLIFFE and HOCKEY, discloses:**

The apparatus of claim 1, wherein the search engine also searches for live users in communities other than said one of the plurality of communities {See SUTCLIFFE, C7:L58-C8:L12, wherein this reads over "[a] first user can request a search of the database for other users based on characteristic and criteria data"}.

18. **As per dependent claims 9 and 19, MATTHEWS, in combination with SUTCLIFFE and HOCKEY, discloses:**

The apparatus of claim 1, wherein the at least one profile of the live user includes one or more labels represent the descriptive information relating to the live user and wherein the search engine searches for another of the plurality of live users using labels associated with profiles of the plurality of live users {See SUTCLIFFE, C5:L22-67, wherein this reads over "characteristic and other data elements"}.

19. **Claim 10-11 and 20-21** are rejected under 35 U.S.C. 103(a) as being unpatentable over MATTHEWS, in view of SUTCLIFFE, in further view of HOCKEY, and in further view of Official Notice.
20. **As per dependent claims 10 and 20**, the Examiner takes Official Notice that it would have been widely known to one of ordinary skill in the art that profiles be created in a plurality of languages (e.g. English, Spanish, Chinese, French, German, and etc.) such that communities may span a plurality of international backgrounds.
21. **As per dependent claims 11 and 21**, the Examiner takes Official Notice that it would have been widely known and apparent to one of ordinary skill in the art to associate languages with a profile and implement a search according to the language characteristic of a plurality of live users.

Response to Arguments

22. Applicant's arguments filed 10 June 2008 have been fully considered but they are not persuasive.
- a. Claim Rejections under 35 U.S.C. 103 in view of Matthew and Hockey
- Applicant asserts the argument that Matthew does not disclose "a system or method wherein a flagging filter flags communications between users based on a textual portion of the communications prior to release to their intended recipient." See Amendment, pages 9-10. The Examiner respectfully disagrees. Specifically, Applicant asserts the argument that because "Hockey states that monitoring the textual content of certain emails that contain viruses or spam would be useless," that Hockey "teaches away from systems wherein communications are filtered based on character strings that the recipient desires not to receive." See Amendment, page 12. The Examiner notes that the Applicant has taken said textual references out of context from the Background to the Invention portion of the Hockey reference. It is further noted that Hockey is directed towards an email monitoring system wherein Spam messages and email worms are detected. Furthermore, Hockey discloses a system wherein textual content of the message or the attached files are used to determine whether said message is a Spam message or an email

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worm. See Hockey, Para. [0102]. In addition, it is noted that Hockey discloses the feature of flagging the message as unsolicited if a certain threshold is exceeded.

While Applicant asserts that Hockey's invention is "based on a review of a numerical digest associated with each communication; not on the textual portion of the communication." See Amendment, page 10. The Examiner respectfully disagrees. Wherein Hockey discloses an invention that generates a summary digest off of the subject line and the message content of the main body, and wherein the message content comprises textual content, it would have been obvious to one of ordinary skill in the art that the review is based on a textual portion of the communication. That is, while Hockey indeed uses a summary digest to make certain determinations, it is noted that said summary digest is based upon the textual portions of the message. Accordingly, said review would comprise at least an analysis of a textual portion of a criterion.

Accordingly, for the aforementioned reasons above, the rejections of claims under 35 U.S.C. 103 are sustained.

Conclusion

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL KIM whose telephone number is (571)272-2737. The examiner can normally be reached on M-F, 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tony Mahmoudi can be reached on (571) 272-4078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul Kim/

Paul Kim
Examiner, Art Unit 2169
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/PK/